REMARKS

Claims 1-23 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

I. Rejection of Claims 1-3, 5, 7, 10-12, 15-23 Under 35 U.S.C. §103(a)

Claims 1-3, 5, 7, 10-12, 15-23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sanada (US 5,843,527) in view of Choi, *et al.* (US 6,089,763). It is respectfully requested that this rejection be withdrawn for at least the following reason. Sanada and Choi, *et al.*, alone and in combination, do not teach or suggest ***all*** the claim limitations.

> To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, ***the prior art reference (or references when combined) must teach or suggest all the claim limitations***. *See* MPEP §706.02(j). (Emphasis added)

In particular, independent claims 1, 15 and 19 recite a visual monitoring system that employs an ***image collector*** to capture reflected energy from inside a ***develop chamber*** and transmit a signal indicative of the interior of the ***develop chamber***. The combination of Sanada and Choi, *et al.* does not teach or suggest such aspects. Rather, both Sanada and Choi, *et al.* disclose monitoring a semiconductor ***coating*** process.

In the Final Office Action (dated January 15, 2004), the Examiner concedes "Sanada does not teach the system being a develop chamber." (*See* Final Office Action, p.3, §2). Then, he asserts that since Choi, *et al.* discloses a spin unit that can be a spin coater or spin developer, "it would be obvious to one skilled in the art at the time of the invention to use the imaging system of Sanada with the spin developer of Choi, *et al.* because the coater and developer are both considered spin units." (*See* Final Office Action, p.3, §2). Applicants respectfully disagree that simply because the coater and developer of Choi, *et al.* are spin units that the asserted

combination is permissible and makes applicants' invention obvious. Rather, "[a] teaching or suggestion to make the claimed combination and a reasonable expectation of success must both be found in the prior art...." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). As discussed in detail *infra*, neither Sanada nor Choi, *et al.* provide a teaching or suggestion to be combined or modified in view of one another to render the subject claims obvious.

As noted in the Reply to the Office Action dated September 30, 2003 and affirmed by the Examiner, Sanada discloses a ***coating*** solution applying method and apparatus and is silent regarding a develop chamber. Since Sanada is only directed toward semiconductor ***coating***, it is readily apparent that Sanada does not provide any teaching, suggestion, motivation or desirability to be modified to include visual monitoring of a develop chamber, as recited in the subject claims. Choi, *et al.* discloses both a coater and a developer and utilization of a CCD camera. However, Choi, *et al.* teaches visual monitoring of the ***coater*** with the CCD camera in order to control the supply of a ***coating*** solvent (*See* col.8, ll.41-67) and does not contemplate monitoring a develop chamber. Since Choi, *et al.* monitors the ***coating*** process, but does not monitor a develop chamber, it is readily apparent that it would not be obvious at the time of the invention to utilize any monitoring system, let alone the monitoring system taught by Sanada, to monitor the developer of Choi, *et al.* Thus, similar to Sanada, Choi, *et al.* does not provide any teaching, suggestion, motivation or desirability to be modified to include visual monitoring of a develop chamber, as recited in the subject claims.

Since Sanada and Choi, *et al.*, individually and in combination, do not teach or suggest ***all*** the claimed limitations or provide any motivation or desirability to be combined or modified in view of each other to teach or suggest ***all*** the claimed limitations, the asserted combination does not make obvious the subject claims and is erroneous. "The teaching or suggestion to make the claimed combination and a reasonable expectation of success must both be found in the prior art, not in applicants' disclosure" (*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)) and "the mere fact that references can be modified does not render the modification obvious unless the cited art also suggests the desirability of the modification" (*In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)).

Thus, it appears that 20/20 hindsight is being impermissibly employed with applicants' specification as a roadmap to make the purported combination; the rationale proffered to modify

and combine Sanada and Choi, *et al.* is to achieve benefits identified in applicants' specification, which overcome problems associated with conventional systems and/or methods. Applicants' representative respectfully submits that this is an unacceptable and improper basis for a rejection under 35 U.S.C. §103. In essence, this rejection is based on an assertion that it would have been obvious to do something not suggested in the art because so doing would provide advantages stated in applicants' specification. This sort of rationale has been condemned by the Court of Appeals for the Federal Circuit. *See. for example, Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987).

In view of the above, it is respectfully submitted that this rejection of independent claims 1, 15 and 19 (and claims 2-3, 5, 7 and 10-12, 16-18, and 20-23, which respectively depend therefrom) should be withdrawn.

III. Rejection of Claims 4, 6, 8-9 and 13-14 Under 35 U.S.C. §103(a)

Claims 4, 6, 8-9 and 13-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sanada (US 5,843,527) in view of Choi, *et al.* (US 6,089,763) and in further view of Stern, *et al.* (US 6,603,874). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Claims 4, 6, 8-9 and 13-14 depend from independent claim 1 and Stern *et al.* does not make up for the aforementioned deficiencies of Sanada and Choi, *et al.* with respect to the independent claim 1. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed Cir. 1988). Thus, for the reasons provided *supra*, this rejection should be withdrawn.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,
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